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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,065	08/18/2003	Bradley Berman	KING. 004CIP1	4199

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EXAMINER	
MOSSER, ROBERT E	
ART UNIT	PAPER NUMBER
3714	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/643,065	BERMAN, BRADLEY	
	Examiner	Art Unit	
	Robert Mosser	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-43 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-43 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 12/04, 8/03.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims **1-42** are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-42, 44-47, 51, and 54-58 of U.S. Patent No. 6,620,045. Although the conflicting claims are not identical, they are not patentably distinct from each other because The presented independent claims of the instant application refer to increasing a players odds of receiving a bonus game in exchange for player assets while the '045 patent teaches providing a bonus game in exchange for player assets.

As the presented in the instant Application the terms "odds" includes "odds" equal to 100% and accordingly encompasses providing a bonus game responsive to the exchange of player assets as set forth in U.S. Patent No. 6,620,045.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims **1-16, 18-35,** and **37-42** are rejected under 35 U.S.C. 102(a) and alternatively under 35 U.S.C. 102(e) as being anticipated by Mayeroff (US 6,186,894). Claims **1-2, 4, 9, 13-15, 18, 20-22, 27-29,** and **37-42** : Mayeroff teaches a method for gaming activity including a base game activity and a bonus game activity alternatively described as a secondary event (Abstract), and further comprising:

receiving an indication from the player to trade player assets for an increased odds of participating in a bonus activity relative to the odds of providing the bonus activity during normal play without the assets traded by the player, through allowing the

player to purchase additional active paylines and therefore receiving additional secondary event combination on these additional paylines that would allow the participate in the secondary event(Col 2:46-53, Col 4:51-64, & Col 7:50-55);

receiving an indication of an amount of player assets offered by the player for the trade (Col 2:42-45);

executing the trade by accepting the player assets offered for trade and altering the odds of participating in the bonus activity responsive thereto (Col 7:50-55); and

presenting the player an opportunity to participate in the bonus activity at the altered odds(Col 7:50-55).

In brief summary of the above the invention of Mayeroff allows a player to place a wager amount beyond a base wager amount to purchase/activate additional paylines on a multi-reel slot machine. As the player receives awards including participation in a secondary event based purely on the symbols appearing on the active payline(s) it is inherent that doubling the number of active paylines would result in a doubling of the odds of being awarded a secondary event. As set forth the process continues to be reflective of the additional paylines activated up to at least 8 additional paylines that may be selectively purchased by the player (Col 2:46-53).

Claims **3,** and **19**: In addition to the above, Mayeroff teaches providing the player with a "direct chance" during each game play to participate in a bonus game as determined by the game symbol outcome in so much as the game outcome has the potential to be a secondary event awarding combination.

Claims **5-8,** and **32-35**: In addition to the above, Mayeroff teaches receiving an unsolicited player request initiated by the player and the gaming activity for allowing the player to select at their additional paylines when placing their wager during a the predetermined occurrence of the wagering opportunity (Col 4:54-64, 5:58-6:4). With relation to whether or not the request is initiated by the gaming activity or the player, the request is viewed as mutual event between the player and the gaming activity as both the player and the gaming device must respectively be willing to place and accept a given wager.

Claims **10-11**: In addition to the above, Mayeroff teaches allowing a player to place a wager prior to the commencement of the rotation of the game reels and after the conclusion of the reels and settlement of any combination of symbols appearing on the paylines resultant of the rotation (Col 5:60-6:4 & 6:55-63).

Claims **12**, and **24**: In addition to the above, Mayeroff teaches allowing a player to "double-up" on their wager during the placement of their initial wager at the same time the player has the ability to exchange player assets for an improved opportunity of receiving a bonus game (Col 5:58-6:4).

Claim **16**: In addition to the above, Mayeroff teaches utilizing player assets acquired through game play (Col 6:55-63) and additionally assets accumulated through the input/deposit of new player assets (Col 5:60-6:4).

Claims **23, 25**: In addition to the above, Mayeroff teaches providing a payout result corresponding to a player participation in a bonus/secondary event (Col 8:1-13). The claimed result being provided to the player at a frequency reflective of the trade value is understood as being encompassed through Mayeroffs' presentation of additional participation opportunities as discussed in the rejection of at least claim 1 above.

Claim **26**: In addition to the above, Mayeroff teaches accepting wagers according to pre-configured criteria (Col 2:46-48).

Claims **30-31**: In addition to the above, Mayeroff teaches a separate bonus/secondary game independent of the based game mode of play (Figure 1, Col 7:56-), and after the completion of the bonus event allowing the player to participate in the standard mode of play through the placement of an additional wager (Claim 1, Col 5:60-6:8).

Claim **38**: In addition to the above, Mayeroff teaches that the use of video displays representation of slot reels is known in the art (Col 4:29-34).

Claim **43** is rejected under 35 U.S.C. 102(b) as being anticipated by Baerlocher et al (US 6,599,192).

Baerlocher et al teach awarding a player increased odds of participating in a Bonus activity through normal play through the awarding of a bonus game and receiving an input by the player to opt out of a the bonus activity in exchange for a payout amount, and resultant thereof awarding the player a payout and terminating the increased odds for participating in a bonus activity through returning the player to the base game (Abstract, Figure 6, Col 6:36-7:13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **17** and **36** are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayeroff (US 6,186,894).

Mayeroff teaches the invention as presented above however, is silent regarding the incorporation of allowing the player to select from multiple bonus game types. The Examiner gives Official Notice that including a plurality of selectable bonus games and allowing a player to select their bonus game type from a plurality of bonus games is old and well known in the art of gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the multiple player selectable bonus games as into the invention of Mayeroff in order to provide the player with variety in their gaming experience thereby adding to the players enjoyment and excitement.

Conclusion

The following prior art made of record and though not relied upon is considered pertinent to applicant's disclosure.

US 6,565,436 Baerlocher teaches the inclusion of multiple bonus games including player selection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MARK SAGER
PRIMARY EXAMINER

RM
March 29th, 2007